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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,021	10/28/2003	Henry Rosenthal	116364	3701
25944	7590	07/07/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			LUONG, VINH	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/694,021

Applicant(s)

ROSENTHAL, HENRY

Examiner

Vinh T Luong

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003 and 20 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

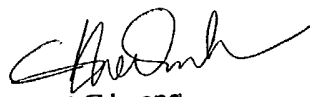
## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some \* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
Vinh T. Luong  
Primary Examiner

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 11122003.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3682

1. This application contains claims directed to the following patentably distinct species of the claimed invention: the species of Figs. 1-3 and the species of Fig. 4.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

*Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.*

2. During a telephone conversation with Mr. Jude Cooney (Registration Number 54,045) on May 18, 2004, a provisional election was made with traverse to prosecute the invention of the species of Figs. 1-3, claims 1-10. Affirmation of this election has been made by applicant in

Art Unit: 3682

Confirmation of Telephone Election filed on May 20, 2004. No claim is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant's election with traverse of the species of Figs. 1-3 in the reply filed on May 20, 2004 is acknowledged. The traversal is on the ground(s) that no basis therefore has been set forth in the *written* record. This is not found persuasive because, pursuant to *telephone* restriction practice set forth in MPEP 812.01, the Examiner was not required to set forth the basis for the restriction in the *written* record *prior* to telephone the Applicant's attorney or agent of record to request an oral election on May 14, 2004. The Examiner was only required to set forth the basis for restriction *orally* by telephone on May 14, 2004. The basis in written record is provided in the Office action following Applicant's oral election as seen in paragraph 1 of this Office action. The requirement is deemed proper and is therefore made FINAL.

4. The drawings are objected to because each part of the invention, such as, the inner and outer layers in claims 4-9, and the base area in claim 10 should be designated by a referential numeral or character. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page

Art Unit: 3682

header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the inner and outer layers in claims 4-9 must be shown or the features canceled from the claims. *No new matter should be entered.*

6. The disclosure is objected to because of the following informalities: each part of the invention, such as, the inner and outer layers in claims 4-9, and the base area in claim 10 should be designated by a referential numeral or character. Appropriate correction is required.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 4-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 4-9 call for the inner and outer layers of different formulations of flexible,

Art Unit: 3682

resilient material. However, the drawings do not show the inner and outer layers. It is unclear as to how Applicant makes/uses the inner and outer layers and attaches them together to form the claimed hand grip.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Larson et al.'315 (EP 0 671 315 A2 cited by applicant).

Larson'315 teaches a hand grip 110 (Figs. 9-11) adapted for fitting onto a motorcycle handlebar end section and comprising a hollow cylindrical body having a first, open end 124, an opposing, second end 120 and an annular flange 126 projecting radially outwards at the first, open end 124, the cylindrical body also having an external surface 112 formed with a plurality of projections 114 distributed thereover, said projections 114 progressively decreasing in height from adjacent the flange 126 to adjacent the second end 120 so as to provide an external taper to the body. *Ibid.*, page 5, line 48 through page 6, line 2.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3682

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larson'315.

Larson teaches the invention substantially as claimed. However, Larson does not teach the external diameter of the cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end.

It is common knowledge in the art at the time the invention was made to form the external diameter of Larson's cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end in order to maximize the amount of torque which may be transmitted from the rider to the hand grip. See Larson, page 3, lines 1-3. The size or dimension of the external diameter of Larson's cylindrical body would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) citing *In re Gal*, 980 F.2d 717, 719, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992). See also *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 45 USPQ2d 1977 (Fed. Cir. 1998) and changes in size/proportion in MPEP 2144.04.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the external diameter of Larson's cylindrical body being reduced

Art Unit: 3682

by less than 5mm from adjacent the flange to adjacent the second end in order to maximize the amount of torque which may be transmitted from the rider to the hand grip as taught or suggested by common knowledge in the art.

14. Claims 1-3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oury (US Des. 284,259).

Regarding claim 1, Oury teaches a hand grip (Figs. 1-5) adapted for fitting onto a motorcycle handlebar end section and comprising a hollow cylindrical body having a first, open end, an opposing, second end and an annular flange projecting radially outwards at the first, open end, the cylindrical body also having an external surface formed with a plurality of projections distributed thereover, said projections progressively *increasing* in height from adjacent the flange to adjacent the second end.

Oury teaches the invention substantially as claimed. However, Oury's projections progressively *increasing instead of decreasing* in height from adjacent the flange to adjacent the second end.

It is common knowledge in the art at the time the invention was made to decrease instead of to increase the height of Oury's projections in order to maximize the amount of torque which may be transmitted from the rider to the hand grip. The reversal/rearrangement of the height of Oury's projections would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. See *In re Chu, supra* and the legal precedents cited for reversal, duplication, or rearrangement of parts in MPEP 2144.04.

It would have been obvious to one having ordinary skill in the art at the time the



Art Unit: 3682

invention was made to decrease instead of to increase the height of Oury's projections in order to maximize the amount of torque which may be transmitted from the rider to the hand grip as taught or suggested by common knowledge in the art.

Regarding claim 2, Oury teaches the invention substantially as claimed. However, Oury does not teach the external diameter of the cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end.

It is common knowledge in the art at the time the invention was made to form the external diameter of Oury's cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end in order to maximize the amount of torque which may be transmitted from the rider to the hand grip. The size or dimension of the external diameter of Oury's cylindrical body would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. See *In re Chu, supra* and legal precedents for changes in size/proportion in MPEP 2144.04.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the external diameter of Oury's cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end in order to maximize the amount of torque which may be transmitted from the rider to the hand grip as taught or suggested by common knowledge in the art.

Regarding claim 3, Oury's second end is closed by an end wall as shown in Fig. 2.

Regarding claim 10, Oury's projections have a base area which *increases* in size from adjacent the flange to adjacent the second end.

It is common knowledge in the art at the time the invention was made to decrease instead

Art Unit: 3682

of to increase the size of the base area of Oury's projections in order to maximize the amount of torque which may be transmitted from the rider to the hand grip. The reversal/rearrangement of the size of the base of Oury's projections would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. See *In re Chu*, *supra* and legal precedents cited for reversal, duplication, or rearrangement of parts in MPEP 2144.04.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to decrease instead of to increase the size of the base of Oury's projections in order to maximize the amount of torque which may be transmitted from the rider to the hand grip as taught or suggested by common knowledge in the art.

15. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oury in view of admitted prior art.

Regarding claims 4 and 7, Oury teaches the invention substantially as claimed. However, Oury does not teach the cylindrical body being formed from an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer.

Admitted prior art described in "Background Art" on pages 1 and 2 of applicant's specification teaches to form the cylindrical body of an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer in order to reduce potential for slippage by the rider's hand.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the cylindrical body of an inner layer and an outer layer of different

Art Unit: 3682

formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer in order to reduce potential for slippage by the rider's hand as taught or suggested by admitted prior art.

16. Claims 4, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oury in view of Jannard et al. (US Patent No. 4,416,166).

Regarding claims 4 and 7, Oury teaches the invention substantially as claimed. However, Oury does not teach the cylindrical body being formed from an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer.

Jannard teaches to form the cylindrical body of an inner layer 11 and an outer layer 13 of different formulations of flexible, resilient material, in which respect the outer layer 13 is of greater flexibility than the inner layer 11 in order to provide better gripping for rider's hand. See Jannard's Summary of the Invention.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Oury's cylindrical body of an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer in order to provide better gripping for rider's hand as taught or suggested by Jannard.

Regarding claims 5 and 8, Jannard teaches the annular flange 11d and the closed end wall 11b formed of the same formulation of material as the inner layer 11 of the cylindrical body in order to provide better gripping for rider's hand.

It would have been obvious to one having ordinary skill in the art at the time the

Art Unit: 3682

invention was made to form Oury's annular flange and closed end wall formed of the same formulation of material as the inner layer of the cylindrical body in order to provide better gripping for rider's hand as taught or suggested by Jannard.

17. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oury in view of Jannard et al. (US Patent No. 4,416,166) and further in view of Downey (US Patent No. 5,261,665).

Regarding claims 6 and 9, Oury teaches the invention substantially as claimed. However, Oury does not teach the inner layer being of substantially constant external diameter, while the outer layer tapered in its external diameter.

Downey teaches the inner layer 12 being of substantially constant external diameter, while the outer layer 14 tapered in its external diameter in order to provide better gripping for rider's hand.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Oury's inner layer as modified by Jannard being of substantially constant external diameter, while the outer layer tapered in its external diameter in order to provide better gripping for rider's hand as taught or suggested by Downey.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Larson'213 (Fig. 2), Thompson (Figs. 1-3), Livingston (Figs. 1-4), Decker et al. (Fig. 1), and Nakaya et al. (Figs. 1-3).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3682

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Luong

June 4, 2004



Vinh T. Luong  
Primary Examiner